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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Federico G. Jaekel

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EXAMINER

LEE, EDMUND H

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/931,170

Applicant(s)

JAEKEL, FEDERICO G.

Examiner

EDMUND H. LEE

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 12-21, 23 and 24 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8, 12-21, 23 and 24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/16/04 has been entered.
2. Claims 1-8, 12-17, and 24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for cooling the entire molded sheet such that it becomes hard and resilient and suitable for use as an exterior body panel, does not reasonably provide enablement for cooling the thermoplastic material on the side opposite the transparent layer such that it becomes sufficiently rigid to form an exterior body panel (cl 1, Ins 10-12; cl 5, Ins 12-14). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. It is clear from the instant specification at pg 3, Ins 16-18 and pg 4, Ins 1-2 that the entire molded sheet is cooled not just the thermoplastic material opposite the transparent layer.
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 12, 14, 16, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (USPN 5230906) in view of Ellison (USPN 6399193). In regard to claim 1, Mueller teaches the basic claimed method including a method of producing an exterior body panel for use on automobile vehicles (col 1, lns 18-20; figs 1-7); providing a decorative web layer (figs 1-7); forming a laminate by providing a thermoplastic material on a top side and on a bottom side of the decorative web layer (figs 1-7); heating the laminate (figs 1-7); conforming the laminate into a desired shape (figs 1-7); and cooling the laminate (figs 1-7)--as a note, it is inherent to cool the molded article in order to produce that can be handled. Also, Mueller teaches using the molded part as a car body part; this teaching constitutes the claimed sufficiently rigid thermoplastic material that forms an exterior body panel. Mueller, however, does not teach a transparent layer. Ellison teaches a method of vacuum forming an exterior body panel (col 1, lns 20-25; col 4, ln 17-col 7, ln 2); and using a laminate having a decorative layer and a substantially transparent layer thereon (col 1, lns 20-25; col 4, ln 17-col 7, ln 2). Mueller and Ellison are combinable because they are analogous with respect to laminates used for automobiles. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use transparent material in the process of Mueller in order to produce a decorative layer having a clear protective coating thereon. In regard to claims 2-4, 12, 14, 16, and 24, Mueller teaches a flexible decorative web material (figs 1-7); pressing the laminate in a vacuum molding die having upper and lower dies (figs 1-7); conforming the laminate to one of the upper and lower dies (figs 1-7); providing a web layer including one of fabric and screening (col 3,

Ins 30-35); and using a thermoplastic material that is an epoxy (col 3, Ins 39-42).

Mueller, however, does not teach applying the thermoplastic material by spraying; applying the thermoplastic material by applying preformed sheets. In regard to applying the thermoplastic material by spraying, such is well-known in the molding art for its ease. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to spray the thermoplastic material of Mueller by spraying instead of using a tank in order to reduce molding complexity. In regard to applying the thermoplastic material by applying preformed sheets, such is well-known in the molding art for its practicality. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use preformed sheets that can be easily stored instead of the tank of Mueller in order to reduce molding complexity.

5. Claims 5-8,13,15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (USPN 5230906) in view of Ellison (USPN 6399193). In regard to claim 5, Mueller teaches the basic claimed method including a method of producing an exterior body panel for use on automobile vehicles (col 1, Ins 18-20; figs 1-7); providing a decorative web layer (figs 1-7); depositing on one side of the decorative web material a mixture of epoxy and plastic which when cured forms a plastic layer (col 3, Ins 39-42; figs 1-7); depositing on an opposite side of the decorative web material a mixture of epoxy and plastic which when cured forms a plastic layer (col 3, Ins 39-42; figs 1-7); heating the decorative web material and the plastic layers (figs 1-7); pressing the decorative web material, the top plastic layer and the bottom plastic layer in a vacuum mold to form a laminate (figs 1-7); and cooling the pressed laminate

(figs 1-7)--as a note, it is inherent to cool the molded article in order to produce that can be handled. Also, Mueller teaches using the molded part as a car body part; this teaching constitutes the claimed sufficiently rigid thermoplastic material that forms an exterior body panel. Mueller, however, does not teach a transparent layer. Ellison teaches a method of vacuum forming an exterior body panel (col 1, lns 20-25; col 4, ln 17-col 7, ln 2); and using a laminate having a decorative layer and a substantially transparent layer thereon (col 1, lns 20-25; col 4, ln 17-col 7, ln 2). Mueller and Ellison are combinable because they are analogous with respect to laminates used for automobiles. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use transparent material in the process of Mueller in order to produce a decorative layer having a clear protective coating thereon. In regard to claims 6-8; 13, 15 and 17, Mueller teaches a flexible decorative web material (figs 1-7); pressing the laminate in a vacuum molding die having upper and lower dies (figs 1-7); removing air from the vacuum mold in forming the molded laminate (figs 1-7); and providing a web layer including one of fabric and screening (col 3, lns 30-35). Mueller, however, does not teach applying the thermoplastic material by spraying; applying the thermoplastic material by applying preformed sheets. In regard to applying the thermoplastic material by spraying, such is well-known in the molding art for its ease. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to spray the thermoplastic material of Mueller by spraying instead of using a tank in order to reduce molding complexity. In regard to applying the thermoplastic material by applying preformed sheets, such is well-known in the molding

art for its practicality. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use preformed sheets that can be easily stored instead of the tank of Mueller in order to reduce molding complexity.

6. Claims 18-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller (USPN 5230906) in view of Ellison (USPN 6399193). In regard to claim 18, Mueller teaches the basic claimed method including a method of producing an exterior body panel for use on automobile vehicles (col 1, lns 18-20; figs 1-7); providing a decorative web layer (figs 1-7); forming a laminate by providing a mixture of an epoxy and a thermoplastic material on a top side and on a bottom side of the decorative web layer (figs 1-7); heating the laminate (figs 1-7); conforming the laminate into a desired shape (figs 1-7); and cooling the laminate (figs 1-7)--as a note, it is inherent to cool the molded article in order to produce that can be handled. Also, Mueller teaches using the molded part as a car body part; this teaching constitutes the claimed attaching the laminate directly to the exterior of a frame of an automobile vehicle. Mueller, however, does not teach a transparent layer. Ellison teaches a method of vacuum forming an exterior body panel (col 1, lns 20-25; col 4, ln 17-col 7, ln 2); and using a laminate having a decorative layer and a substantially transparent layer thereon (col 1, lns 20-25; col 4, ln 17-col 7, ln 2). Mueller and Ellison are combinable because they are analogous with respect to laminates used for automobiles. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use transparent material in the process of Mueller in order to produce a decorative layer having a clear protective coating thereon that faces away from the frame of the

automobile. In regard to claims 19-21 and 23, Mueller teaches pressing the laminate in a vacuum mold (figs 1-7). Mueller, however, does not teach applying the thermoplastic material by spraying; applying the thermoplastic material by applying preformed sheets. In regard to applying the thermoplastic material by spraying, such is well-known in the molding art for its ease. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to spray the thermoplastic material of Mueller by spraying instead of using a tank in order to reduce molding complexity. In regard to applying the thermoplastic material by applying preformed sheets, such is well-known in the molding art for its practicality. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use preformed sheets that can be easily stored instead of the tank of Mueller in order to reduce molding complexity.

7. Applicant's arguments with respect to claims 1-8, 12-17, 18-21, and 23-24 have been considered but are moot in view of the new ground(s) of rejection.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kasari et al (USPN 5366768) teach an epoxy-resin clear coat from automobiles.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDMUND H. LEE  
Primary Examiner  
Art Unit 1732



6/1/04

EHL